

REMARKS

Claims 1-32 are pending in this application. Claims 1-12, 15-17, 21-24, and 29-31 are allowed. Claims 1 and 7 have been amended without prejudice or acquiescence in order to advance prosecution of the instant application. Applicants note that the amendment of “medicinal” to “pharmaceutical” in claims 1 and 7 is tangential. The issues outstanding in the instant application are as follows:

- Claims 13, 14, 18, 19, 20, 25-28, and 32 have been rejected under 35 U.S.C. § 102(b)/103(a) as allegedly being anticipated by and/or obvious over CN 1210695.

35 U.S.C. § 102(b)/103(a) issues

The Examiner has rejected claims 13, 14, 18, 19, 20, 25-28, and 32 under 35 U.S.C. § 102(b)/103(a) as allegedly being anticipated by and/or obvious over CN 1210695. Applicants respectfully traverse.

CN 1210695 teaches drinking water with calcium salts in concentrations of 10-1,000mg/L. Applicants teach a method of inhibiting phosphorous absorption in the gastrointestinal tract by administration of an effective amount of a calcium glutarate composition in a single dose form, said composition excluding non-glutarate calcium salts in amounts sufficient to neutralize gastric acidity. Applicants also teach single dose compositions and compounds of calcium glutarate sufficient to bind with phosphorous in the gastrointestinal tract.

There is no inherent anticipation of the claimed invention, as the limitations taught by applicants are **not necessarily** present in CN 1210695. Inherency may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient to establish inherency. See *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1269, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991). *Continental Can* test establishes a narrow scope of inherency. It requires that an undisclosed element is a technological fact. Further, inherent anticipation requires that the missing descriptive material is **"necessarily present,"** not merely probably or possibly present, in the prior art. *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). Inherency

does not embrace probabilities or possibilities. In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1951 (Fed. Cir. 1999).

The drinking water of CN 1210695 is **not necessarily** sufficient for inhibiting phosphorous absorption, as there is no teaching of expected consumed doses of the drinking water. Furthermore, drinking water is normally consumed in different amounts by different individuals, thus there is only a **possibility** that consumed amounts could provide therapeutic doses. Applicants specifically teach that the claimed composition comprises a **single dose** sufficient to bind with phosphorous in the gastrointestinal tract. As one with skill in the art cannot deduce from CN 1210695 that the drinking water will be consumed in doses sufficient to bind with phosphorous in the gastrointestinal tract, single doses of therapeutic value are not necessarily taught by CN 1210695. Thus, CN 1210695 does not meet the *Continental Can* test for inherent anticipation.

The drinking water taught by CN 1210695 does **not necessarily** exclude compositions with non-glutarate calcium salts in amounts sufficient to neutralize gastric acidity. CN 1210695 teaches that any of a variety of calcium salts may be dissolved in water, as the drinking water is adapted to be a nutritional supplement. Thus, there is only a **possibility** that drinking water according to CN 1210695 would specifically exclude non-glutarate calcium salts in amounts sufficient to neutralize gastric acidity. As several different calcium salts are taught as appropriate for use by CN 1210695, one with skill in the art would **not necessarily** be lead to compositions excluding non-glutarate calcium salts in amounts sufficient to neutralize gastric acidity.

CN 1210695 does not teach or suggest a method of inhibiting phosphorous absorption in the gastrointestinal tract. CN 1210695 does not teach or suggest compositions excluding non-glutarate calcium salts in amounts sufficient to neutralize gastric acidity. CN 1210695 does not teach or suggest single dose compositions. Thus, CN 1210695 does not teach or suggest all the limitations of the claimed invention and there is no anticipation of claims directed towards compositions for or methods of inhibiting gastrointestinal absorption of phosphorous as taught by Applicants. As CN 1210695 does not teach or suggest all the limitations of the claimed invention, Applicants respectfully request withdrawal of the 35 U.S.C. § 102(b)/103(a) rejection.

Application No.: 09/919,025

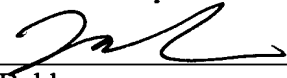
Docket No.: HO-P02490US0

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 06-2375, under Order No. HO-P02490US0 from which the undersigned is authorized to draw.

Dated: *June 23, 2004*

Respectfully submitted,

By 
Jila Bakker

Registration No.: 53,962
FULBRIGHT & JAWORSKI L.L.P.
1301 McKinney, Suite 5100
Houston, Texas 77010-3095
(713) 651-5151
(713) 651-5246 (Fax)
Attorney for Applicant